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Date: November 15, 2005

To: Examiner Son T. Nguyen Art Unit: 3643
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Debi Labay

Our Ref: WHIT0019.A
Serial No: 10/823,379
Our Deposit Account Log No.: 1114
Confirmation No: 3362

Pages: 40
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- 3) Appeal Brief.

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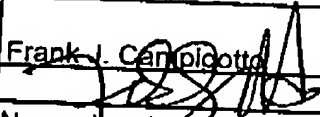
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/823,379	RECEIVED CENTRAL FAX CENTER NOV 15 2005
	Filing Date	April 13, 2004	
	First Named Inventor	Carl E. Whitcomb	
	Art Unit	3643	
	Examiner Name	Son T. Nguyen	
Total Number of Pages in This Submission	39	Attorney Docket Number	WHIT/0019.A

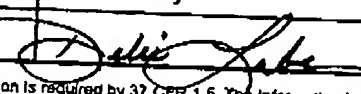
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FEE TRANSMITTAL

For FY 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 250.00

Complete if Known

Application Number **10/823,379**
 Filing Date **April 13, 2004**
 First Named Inventor **Carl E. Whitcomb**
 Examiner Name **Son T. Nguyen**
 Art Unit **3643**
 Attorney Docket No. **WHIT-0019.A**

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims _____ **Extra Claims** _____ **Fee (\$)** _____ **Fee Paid (\$)** _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims _____ **Extra Claims** _____ **Fee (\$)** _____ **Fee Paid (\$)** _____

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Multiple Dependent Claims _____ **Fee (\$)** _____ **Fee Paid (\$)** _____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

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Non-English Specification, \$130 fee (no small entity discount)

Other: Appeal Brief

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Date November 15, 2005

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Appeal Brief
Docket No.: WHIT/0019.A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE APPLICATION OF:
Carl E. Whitcomb

SERIAL NO: 10/823,379

CONFIRMATION NO.: 3362

FILED: April 13, 2004

FOR: Plant Container Base with Root-Directing Channels

www.ck12.org

EXAMINER: Nguyen, Son T.

GROUP ART UNIT: 3643

Via Facsimile: 571-273-8300

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APPEAL BRIEF

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Appeal Brief
Docket No.: WHIT/0019.A

TABLE OF CONTENTS

Table of Contents.....	i
Table of Authorities	iii
(1) Real Party in Interest.....	1
(2) Related Appeals and Interferences	1
(3) Status of the Claims.....	1
(4) Status of Amendments	1
(5) Summary of Claimed Subject Matter.....	1
(6) Grounds of Rejection to be Reviewed on Appeal.....	3
(7) Argument.....	4
a. Claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62, 63 stand rejected under 35 U.S.C. 103(a)	4
1. Review of the cited prior art	4
2. Applicable law	5
3. No evidence of teaching, suggestion or motivation to combine the cited prior art references	9
4. Rejection based upon impermissible hindsight-based obviousness analysis.....	15
5. Summary.....	17
b. Claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41, 61 stand rejected under 35 U.S.C. 103(a)	19
1. Review of the cited prior art	19
2. No teaching or suggestion of each and every limitation of claims 8, 18 and 29	19
3. No teaching or suggestion of each and every limitation of	

Appeal Brief
Docket No.: WHIT/0019.A

claims 21, 22 and 23	20
4. Rejection based upon impermissible hindsight-based obviousness analysis.....	21
5. Summary	23
Prayer	24
Appendix	25

Appeal Brief
Docket No.: WHIT/0019.A

TABLE OF AUTHORITIES

CASES

<i>C.R. Bard, Inc. v. M3 Sys., Inc.</i> , 157 F.3d 1340 (Fed. Cir. 1998).....	9, 15
<i>Hybritech, Inc. v. Monoclonal Antibodies, Inc.</i> , 802 F.2d 1367 (Fed. Cir. 1986).....	6, 17
<i>In re Antonie</i> , 195 U.S.P.Q. 6 (CCPA 1977).....	6
<i>In re Fritch</i> , 972 F.2d 1260 (Fed. Cir. 1992).....	9
<i>In re Kotzab</i> , 217 F.3d 1365 (Fed. Cir. 2000).....	8, 16
<i>In re Lee</i> , 277 F.3d 1338 (Fed. Cir. 2002).....	7, 11
<i>In re McLaughlin</i> , 443 F.2d 1392 (CCPA 1971).....	9, 16
<i>In re Mills</i> , 916 F.2d 680 (Fed. Cir. 1990).....	7, 11
<i>In re Rouffet</i> , 149 F.3d 1350 (Fed. Cir. 1998).....	7, 10, 11, 14
<i>In re Royka</i> , 490 F.2d 981 (CCPA 1974).....	6, 20
<i>In re Wilson</i> , 424 F.2d 1382 (CCPA 1970).....	6
<i>In re Wood</i> , 799 F.2d 1032 (CCPA 1979).....	14
<i>In re Wright</i> , 802 F.2d 1367 (Fed. Cir. 1986).....	5
<i>Interconnect Planning Corp. v. Feil</i> , 774 F.2d 1132 (Fed. Cir. 1985).....	9, 16, 20
<i>Jones v. Hardy</i> , 727 F.2s 1524 (Fed. Cir. 1984).....	6

STATUTES /REGULATIONS

35 U.S.C. 103(a).....	3, 4, 5, 19
37 C.F.R. 41.37.....	1

Appeal Brief
Docket No.: WHIT/0019.A

APPEAL BRIEF

Appellant timely filed a Notice of Appeal to this Board on September 22, 2005 appealing the decision of the Examiner in the Final Office Action dated June 15, 2005 for the above captioned application. Appellant hereby submits this Appeal Brief pursuant to 37 C.F.R. 41.37.

(1) REAL PARTY IN INTEREST

The real party of interest in this action is Lacebark, Inc., the recorded assignee of the entire right, title and interest in and to the patent application now under appeal before this Board. Lacebark, Inc. is a corporation of the State of Oklahoma, having a place of business at Stillwater, Oklahoma.

(2) RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, Appellant's legal representative, or Assignee that will affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

(3) STATUS OF THE CLAIMS

The status of all claims in the application under appeal is as follows: claims 1-64 are pending in the application. Claims 25, 30, 39, 42-59 and 64 stand withdrawn from consideration. Claims 1-24, 26-29, 31-38, 40-41 and 60-63 stand rejected. All of the rejected claims are under appeal.

(4) STATUS OF AMENDMENTS

No amendments to any of the claims have been requested.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

Appellant identified a need to provide a plant container having a base that promotes the health of roots by preventing root circling. (Specification, ¶ 7). Root circling occurs when the

Appeal Brief
Docket No.: WHIT/0019.A

plant roots contact a smooth surface of the plant container and are deflected along the curvature of the surface until they have formed a coil at the bottom of the container. (Specification, ¶ 2). In the art of plant-growing containers, root pruning sidewalls have been developed that reduce the problem of root circling by air pruning the roots when they contact the side surfaces, thereby causing the root to branch and develop into a larger and healthier root system. (Specification, ¶ 3). The effect of the container base on root circling was identified by Appellant as being a cause for less healthy root systems and led Appellant to invent the plant container and base that are claimed as the present invention.

The plant container of the claimed invention includes base for a container used for growing plants. (Specification, ¶ 31). The base forms the floor of the container and supports and retains growth medium, such as soil, within the container. *Id.* The term “base” is used and defined in the specification as being “a foundation that supports the growth medium for the plant.” (Specification, ¶ 58). The base may form a container by combining with various sidewalls or panels, including flexible panels having protuberances that retain the base therebetween and rigid pots that integrate the base into a unitary container. (Specification, ¶ 31).

When the base is used with a flexible sidewall, the sidewall panel is wrapped around the perimeter of the base to engage and support the perimeter of the base on a plurality of shoulders. (Specification, ¶ 39). The plurality of the sidewall’s shoulders that support the base may be, for example, shoulders dedicated to providing support, shoulders provided by the inner surface of an outwardly extending protuberance, shoulders provided by the outer surface of an inwardly extending protuberance or some combination thereof. (Specification, ¶ 39). For example, FIG. 2C shows a cross-sectional side view of the base 30 retained to an air-root-pruning panel 42

Appeal Brief
Docket No.: WHIT/0019.A

formed into a sidewall of the container 40. (Specification, ¶ 45). The perimeter 18 of the base 30 is supported on the inside surface 48 of a row of protuberances 44. *Id.*

Importantly, the base has an upwards facing surface with a plurality of radially directed channels that direct the roots in a generally radial direction. (Specification, ¶ 37). For example, FIG. 2A is a top view of a base 30 having a plurality of channels 16 extending radially from the central dome 12 to a perimeter edge 18. (Specification, ¶ 43). The plurality of channels on the upper surface of the base are disposed in a radial pattern to prevent root circling along the bottom of the container. (Specification, ¶ 35).

The upper surface of the base is preferably sloped downwardly from the center to the perimeter so that the roots are directed outwardly towards the perimeter rather than inwardly toward the center. *Id.* While the slope may be at a constant angle or a changing angle, the preferred slope is provided by a convex surface in combination with a central dome extending upward from the center of the convex surface so that even roots directed straight downward into contact with the center of the base will be unlikely to deflect back upward. (Specification, ¶ 36). For example, FIG. 2A shows a central dome 12 with the plurality of channels 16 extending radially therefrom and FIG. 2B illustrates the convex shape of the base 30.

Where the container sidewall includes openings such as air-root-pruning elements, protuberances or drain holes, the distal end of the channel will preferably be disposed or aligned to direct roots into an opening. (Specification, ¶ 38).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- a. Claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62, 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent Application No. GB 2,350,272 of Single in view of U.S. Patent No. 603,492 issued to Waterer.

Appeal Brief
Docket No.: WHIT/0019.A

b. Claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41, 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent Application No. GB 2,350,272 of Single in view of U.S. Patent No. 603,492 issued to Waterer as applied to claim 1 above, and further in view of U.S. Patent 4,628,634 issued to Anderson.

(7) ARGUMENT

a. Claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62, 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent Application No. GB 2,350,272 of Single in view of U.S. Patent No. 603,492 issued to Waterer.

(1) Review of the cited prior art. Single discloses a container for above ground plant growth that comprises a flexible strip of material having an inner surface formed in part by a lattice of root guiding recesses or inner cusps. (Single, p. 1, ¶ 5). The container further comprises a base capable of supporting a load within the container and further functions to control the downward extension of root growth by coating the inside surface of the base with a chemical growth retardant. (Single, p. 1, ¶ 6). Any root growth that extends down to the base is pruned by the copper-based compound and such pruning causes secondary roots to form. (Single, p. 2, ¶ 3). Single discloses that the base is supported and retained in position by cooperation with the side walls that have a series of inwardly projecting cones or cusps that are used to support the base. (Single, p. 4, ¶ 6).

Waterer discloses a jardinière, which is defined by the Merriam-Webster dictionary as a: an ornamental stand for plants or flowers; b: a large usually ceramic flowerpot holder. Waterer discloses that his invention relates to jardinières for *containing the pots* of growing plants for ornamental purposes and has for its object the greater facility of watering and caring for such

Appeal Brief
Docket No.: WHIT/0019.A

plants with the least risk of soiling surrounding carpets, furniture or floors. (Waterer, p. 1, lines 11-15).

Waterer discloses, in FIG. 1, that the jardinière includes sides 2 and a bottom 3 that is nearly or quite flat and in the bottom is an outlet-opening 6 with a faucet 8 attached thereto. (Waterer, p. 1, lines 54-61). The jardinière is shown holding a flower pot. (Waterer, FIG. 1). FIG. 5 shows a perspective view of an elastic stand 20 for supporting the flower pot within the jardinière. The stand 20 is formed as a flat plate 21 with *radial ribs 22* raised on the upper side so as to *permit water to flow outwardly from the central opening in the bottom of the flower pot*, down the inclined rim 23 and through the perforations 23' and notches 23'' in the lower edge of the stand 20 to permit water to flow to the outlet 6. (Waterer, p. 1, line 95 – p.2, line 3) [Emphasis added].

Waterer discloses that the ductile plate-metal support, or stand 20, for the flower pot provides for the free egress of *water from the flower pot* when it is required to be drained and is valuable for protecting the jardinière from breakage in placing the flower pot in it by preventing the flower pot from coming into contact directly with the bottom of the jardinière. (Waterer, p. 2, lines 16-25) [Emphasis added].

(2) Applicable law. The invention as a whole must be obvious. A claimed invention is unpatentable if the differences between it and the prior art “are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. 103(a) [emphasis added]. “The invention as a whole embraces the structure, its properties, and the problems it solves.” *In re Wright*, 6 U.S.P.Q.2d 1959, 1963 (Fed. Cir. 1988). In delineating the invention as a whole, we look not just to the subject matter which is literally recited in the claim in question . . . but also to those properties of

Appeal Brief
Docket No.: WHIT/0019.A

the subject matter which are inherent in the subject matter and are disclosed in the specification.”

In re Antonie, 195 U.S.P.Q. 6, 8 (CCPA 1977).

As the Federal Circuit has stated, “Focusing on the obviousness of substitutions and differences instead of on the invention *as a whole* . . . was a legally improper way to simplify the difficult determination of obviousness.” *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383 (Fed. Cir. 1986) [emphasis added].

All the claim limitations must be taught or suggested. To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Federal Circuit has made clear that all claim limitations must be considered and that it is impermissible to merely consider the “idea” of an invention. In *Jones v. Hardy*, 727 F.2d 1524 (Fed. Cir. 1984), the Federal Circuit stated:

Under the patent statute, Title 35 U.S.C., “ideas” are not patentable; claimed structures and methods are. Reducing a claimed invention to an “idea,” and then determining patentability of that “idea” is error. Analysis properly begins with the claims, for they measure and define the invention.

Id. at 1527 [citations omitted].

Furthermore, regarding the requirement that for establishing a *prima facie* case of obviousness all the claim limitations must be taught or suggested by the prior art, the *Jones* Court stated:

The “difference” may have seemed slight (as has often been the case with some of history’s greatest inventions, *e.g.* the telephone) but it may also have been the key to success and advancement in

Appeal Brief
Docket No.: WHIT/0019.A

the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

Id. at 1528.

There must be a basis for combining or modifying prior art references. To establish a *prima facie* case of obviousness of a claimed invention, the Examiner must provide a basis for combining or modifying the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In the case *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998), the Court states:

When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. *Although the suggestion to combine references may flow from the nature of the problem, the suggestion more often comes from the teachings of the pertinent references or from the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field.* Therefore, when determining the patentability of a claimed invention which combines two known elements, *the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.*

Id. at 1356 [citations omitted] [Emphasis added].

In the case *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002), the Federal Circuit held:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes *evidence* relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Id. at 1343, emphasis added.

Appeal Brief
Docket No.: WHIT/0019.A

The courts have recognized that most inventions are made up of elements that have already been discovered and utilized. It is the specific combination of these elements, however, that define the invention being claimed. For example, in the case *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), the Court states:

Most, if not all inventions arise from a combination of old elements . . . Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

Id. at 1395.

The *Kotzab* Court further distinctly points out the requirement that particular findings are required as to the justification of combining references. The Court stated:

Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. The motivation, suggestion or teaching may come explicitly from statement in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art . . . Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not evidence.

Id. at 1370.

Appeal Brief
Docket No.: WHIT/0019.A

Hindsight-based obviousness analysis is forbidden. The case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching, suggestion, or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)(describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”). As the Federal Circuit has instructed, the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). The examiner can satisfy the burden of obviousness in light of combination “only by showing some objective teaching [leading to the combinations].” *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Further considering the impermissible use of hindsight obviousness analysis in the case *In re McLaughlin*, 443 F.2d 1392 (CCPA 1971), the Court stated:

It should be too well settled now to require citation or discussion that the test for combining references is not what the individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. Any judgment of obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made *and does not include knowledge gleaned only from applicant's disclosure*, such a reconstruction is proper.

Id. at 1395, emphasis added.

(3) The Examiner has presented no evidence of a teaching, suggestion or motivation to combine the cited prior art references. When determining the patentability of a claimed

Appeal Brief
Docket No.: WHIT/0019.A

invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination. *In re Rouffet*, 149 F.3d at 1356 [Emphasis added].

Appellant claims, *inter alia*, a plant container having a sidewall and a base, the base further having an upwardly facing surface with a plurality of radially directed channels. (Claims 1 and 60). The Examiner has determined that Single includes each of these limitations except for the base having a plurality of radially directed channels. (Final Office Action, p. 2, sec. 2, ¶ 2). For this limitation of Appellant's claimed invention, the Examiner cites Waterer as teaching a plant container having a base with radially directed channels. *Id.* To support this combination of the prior art, the Examiner states, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ radially directed channels as taught by Waterer on the base of Single in order to permit water to flow from the central area." *Id.* The Examiner states, "Obviously the motivation to combine Single with Waterer is to direct water to flow from the central area as taught by Waterer of the base of Single." (Final Office Action, p. 8, ¶ 2).

The Examiner mischaracterizes the teaching of Waterer. Waterer *does not disclose, teach or suggest* that the purpose of the *channels* is to direct water flow from the central area of the base as the Examiner states. Rather, Waterer discloses at that portion cited and mischaracterized by the Examiner:

The stand 20 is formed as a flat ductile-metal plate 21, with radial ribs 22 raised on the upper side, so as to permit water to flow outwardly from the **central opening in the bottom of the flower-pot**, and with a downwardly and outwardly included rim 23 having . . ."

Waterer, page 1, lines 95-100.

Appeal Brief
Docket No.: WHIT/0019.A

Therefore, Waterer *does not disclose, teach or suggest* that the purpose of the *channels* is to direct water from the central area of the base; rather, Waterer discloses that the purpose of the *ribs* is to permit water to flow outwardly from the *central opening in the bottom of the flower-pot* sitting on the raised *ribs*. Raising the bottom of the flower-pot slightly above the flat base by setting the flower-pot on the raised ribs ensures that the central opening in the bottom of the flower pot is not blocked off so that water can freely flow from the central opening in the bottom of the flower pot. This is not the same as the Examiner's mischaracterization of the disclosure, *i.e.*, that the purpose of the *channels* is to direct water flow from the central area of the *base*. Waterer merely discloses that ribs are used to lift the bottom of the flower-pot above the base so that water can freely drain from the opening in the **bottom of the flower-pot**.

The Examiner has failed to provide the required "*evidence* relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." *In re Lee*, 277 F.3d at 1343 [Emphasis added]. The Examiner mischaracterized the teachings of Waterer as to why Waterer has radially directed channels and further provided *no evidence*, as required by the Federal Circuit, as to why one having ordinary skill in the art would seek to modify or combine the cited references. The mere fact that references *can be* combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination. *In re Mills*, 916 F.2d 680.

The required evidence of a motivation or suggestion to combine the prior art "may flow from [1] the nature of the problem, [although] the suggestion more often comes from [2] the teachings of the pertinent references or from [3] the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field." *In re Rouffet*, 149 F.3d at 1356.

Appeal Brief
Docket No.: WHIT/0019.A

Looking at each of these sources for the required evidence, first, there is no motivation or suggestion to combine the Single and Waterer references based upon the nature of the problem sought to be solved. Single addresses the problem of the lack of control of the downward extension of the root growth of a plant within a container and solves this problem by adding a coating of a chemical growth retardant to the base so that any root coming in contact with the growth retardant is pruned. (Single, p. 2, ¶ 3). Waterer addresses the problem of soiling surrounding carpets, furniture or floors as a result of plant watering and provides a jardinière for protecting these items from water. There are no plant roots in contact with the jardinière of Waterer since Waterer merely discloses a container for containing the pots of growing plants. (Waterer, p. 1, lines 11-15). Appellant identified the problem of root circling at the bottom of a plant container and solved the problem by providing radially directed channels to channel the roots to the sides for pruning by the sidewalls. The Examiner claims the motivation to combine these cited prior art references "obviously is to direct water from the central area of the base." (Final Office Action, p. 8, ¶ 2). The Examiner has not provided evidence of such motivation flowing from the problems sought to be solved since the problems to be solved, *i.e.*, root circling at the bottom of a container and soiling of carpets and furniture during plant watering, are not concerned with "directing water from the central area of the base."

Secondly, the Examiner has failed to provide any evidence of a motivation or suggestion to combine the Single and Waterer references based upon the teachings of the prior art references. Instead, the Examiner merely mischaracterizes the teachings of Waterer (Waterer, p.1, lines 95-100), by stating that the channels permit water to flow from the central area of the base, and then asserts that such mischaracterized teachings are the motivation to combine the cited prior art references. (Final Office Action, p. 2, sec. 2, ¶ 2).

Appeal Brief
Docket No.: WHIT/0019.A

As discussed, *supra*, Waterer teaches ribs that "permit water to flow outwardly from the central opening in the bottom of the flower-pot" (Waterer, p.1, lines 95-100) rather than channels that "direct water to flow from the central area . . . of the base" (as the Examiner mischaracterized Waterer in the Final Office Action). The differences between the actual statement of Waterer and the Examiner's mischaracterization of Waterer are critical and telling.

Waterer's radial ribs 22 support a flower-pot above the surface of the flat plate 21 of the stand 20 to provide for the free egress of water out of a hole in the bottom of a standard flower-pot. The ribs simply prevent blockage of the flower-pot's drainage hole by elevating the hole above the flat surface 21 of the stand 20 that would otherwise block the hole of the flower-pot. Furthermore, the function and structure of the ribs is to raise and support the bottom of a flower-pot and prevent blockage of the hole, so that water can exit the hole in the flower-pot. Waterer does not teach, show or suggest that the ribs would serve any function other than providing for "free egress of water from the flower pot." (Waterer, page 2, lines 16-30). Single is silent as to the flow of water in the container disclosed therein. Therefore, there is no motivation or suggestion to combine the Single and Waterer references based upon the teachings of the prior art references themselves.

Finally, looking at the third source enumerated in *Rouffel* from which evidence may be drawn to support the motivation to combine cited prior art references, the Examiner has failed to provide any evidence of a motivation to combine Single and Waterer flowing from the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field. There is simply nothing that indicates that these cited prior art references are of special importance in a particular field.

Appeal Brief
Docket No.: WHIT/0019.A

Therefore, the Examiner has failed to provide any evidence of the motivation to combine the cited prior art reference that flows from (1) the nature of the problem to be solved, (2) the teachings of the cited prior art references or (3) the ordinary knowledge of those skilled in the art that certain references are of special importance in a particular field.

Furthermore, the Examiner has failed to answer the question of "whether there is something in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination. *In re Rouffet*, 149 F.3d at 1356 [Emphasis added]. The Examiner has provided only the mischaracterized statement from the disclosure of Waterer, as discussed above, as a motivation to combine the cited prior art references by stating, "Obviously the motivation to combine Single with Waterer is to direct water to flow from the central area as taught by Waterer of the base of Single." (Final Office Action, p. 8, ¶ 2). Without even considering that Waterer does not teach what the Examiner claims Waterer teaches, there is still no explanation from the cited prior art references or from the Examiner as to *why directing water from the central area would be beneficial*, and thus obvious.

Indeed, if the cited prior art references were combined, the ribs of Waterer would no longer serve their stated function (permitting water to flow outwardly from the central opening in the bottom of the flower-pot by elevating the bottom of the flower-pot above the base) outside the context of supporting a flower pot. There is no reasonable basis disclosed by the references, cited by the Examiner or otherwise known, to consider that Waterer's ribs would assist water flow across an otherwise flat base of both Waterer and Single. Waterer's ribs are raised up from the flat plate 21 and presumably have a uniform height to make contact across the flat bottom of the flower pot. (Waterer, Figs. 1 and 5). This construction is *not expected to direct water flow*, as claimed by the Examiner, since neither the ribs nor the base is pitched. Furthermore, since the

Appeal Brief
Docket No.: WHIT/0019_A

base of Single is flat and not pitched, there is no reason to expect that the combination of features would direct water flow either. Waterer's only disclosed reason for the ribs is for permitting water to flow outwardly from the central opening in the bottom of the flower-pot. There is nothing in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination.

Therefore, because (1) the Examiner has failed to answer the question of whether there is something in the prior art references as a whole to suggest the desirability, and thus the obviousness, of making the combinations and (2) the Examiner has failed to provide any *evidence* of the motivation to combine the cited prior art references, Appellant respectfully asserts that the Examiner has failed to provide a *prima facie* case of obviousness. Appellant respectfully requests the Board to find that independent claims 1 and 60, as well as all claims depending therefrom that are presented on appeal, are patentable.

(4) The rejection is based upon impermissible hindsight-based obviousness analysis by the Examiner. There being no evidence of a teaching, suggestion or motivation to combine the cited references, Appellant asserts that the Examiner has fallen into the hindsight trap, using Appellant's specification as the motivation to combine the cited references. As the courts have instructed, the case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching, suggestion, or motivation to combine prior art references. *C.R. Bard*, 157 F.3d at 1352. Any judgment of obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made *and does not include*

Appeal Brief
Docket No.: WHIT/0019.A

knowledge gleaned only from applicant's disclosure, such a reconstruction is proper. *McLaughlin*, 443 F.2d at 1395.

The use of hindsight-based obviousness analysis by the Examiner for determining obviousness is not permitted. As the Federal Circuit has instructed, the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time. *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1138.

Appellant disclosed and claimed a base having a plurality of radially directed channels to direct the roots of a plant growing in the container to the sides for pruning. Without Appellant's specification, there is no teaching, suggestion or motivation to combine the cited references. Without the knowledge of directing the roots to the container sides for pruning, *which was gleaned only from the Appellant's disclosure*, there would be no motivation, suggestion or teaching to combine the cited references. As discussed in the section above, the Examiner failed to provide the required showing of the teaching, suggestion or motivation to combine the cited prior art references. Instead, the Examiner has resorted to hindsight-based obviousness analysis to search for and find each of Appellant's claimed limitation in a prior art reference. The Examiner then combined these cited prior art references, found only through impermissible hindsight-based obviousness analysis, without the requisite showing of the teaching, suggestion or motivation to combine them.

As the *Kotzab* Court taught, "Most, if not all inventions arise from a combination of old elements . . . Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d at 1395. Merely finding the Single and Waterer prior art references using information gleaned only from Appellant's

Appeal Brief
Docket No.: WHIT/0019.A

specification, without providing evidence of the motivation to combine them, is using impermissible hindsight-based obviousness analysis.

As the Federal Circuit has stated, "Focusing on the obviousness of substitutions and differences instead of on the invention *as a whole* . . . was a legally improper way to simplify the difficult determination of obviousness." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1383. Because the Examiner has used information gleaned only from Appellant's specification, using Appellant's specification as a blueprint to focus on the obviousness of substitutions and differences instead of the invention as a whole, Appellant respectfully asserts that the Examiner has impermissibly used hindsight-based analysis to reject Appellant's claims. Therefore, Appellant respectfully requests the Board to find that the claims submitted on appeal are patentable.

(5) Summary. Appellant respectfully asserts that the Examiner has failed to provide a *prima facie* case of obviousness for the reasons that follow.

1. The Examiner has failed to provide the required evidence of the teaching, suggestion or motivation to select and combine the references relied on as evidence of obviousness. One having ordinary skill in the art would not find it **desirable, and thus obvious**, to combine the cited prior art references *without* the teaching and disclosure gleaned only from Appellant's specification.

2. The Examiner has failed to provide evidence of a teaching, suggestion or motivation to combine the cited prior art references based upon the nature of the problem to be solved. The natures of the problems to be solved by the prior art references are different and unrelated. Single attempted to solve the problem of root penetration to the base of a container

Appeal Brief
Docket No.: WHIT/0019.A

while Waterer attempted to solve the problem of soiling furniture and floors when a plant is being watered.

3. The Examiner has failed to provide evidence of a teaching, suggestion or motivation to combine the cited prior art references based upon a teaching from within the prior art references themselves. Even though the Examiner claims the motivation to combine the references flows from the teachings of the prior art references, the "teaching" relied on by the Examiner is a mischaracterization of the disclosure of Waterer. Waterer does not teach that the channels direct water from the central area of the base as characterized by the Examiner. Instead, Waterer states that the ribs permit water to flow outwardly from the central opening in the bottom of the flower-pot. However, even if the mischaracterized teaching of Waterer by the Examiner was the teaching of Waterer, it is inapplicable to the Appellant's claimed invention and there is no evidence that the channels of Waterer would permit the flow of water if they were filled with dirt.

4. The Examiner has failed to provide evidence of a teaching, suggestion or motivation to combine the cited prior art references based upon a conclusion by one having ordinary skill in the art that the cited references are of special importance in a particular field.

5. Since the Examiner has failed to provide any evidence to support a motivation to combine the prior art references, it is only through the impermissible use of hindsight-based obviousness analysis, using only knowledge gleaned from Appellant's disclosure, that the Examiner has identified and combined the cited prior art references.

6. Appellant respectfully asserts that the Examiner has lost track of the "subject matter as a whole" and has impermissibly focused on the obviousness of substitutions and differences instead of focusing on the invention as a whole. Using impermissible hindsight

Appeal Brief
Docket No.: WHIT/0019.A

analysis, the Examiner has sought to find in the cited references the limitations claimed by Appellant without regard either to what the cited references teach or what the Appellant's claimed invention is as a whole.

For the reasons provided, *supra*, Appellant respectfully requests the Board to find that claims 22-28, 30, 31, 33, 34, 36 and 37 presented on appeal are patentable.

b. Claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41 and 61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over GB Patent Application No. GB 2350272A of Single in view of U.S. Patent No. 603,492 issued to Waterer as applied to claim 1 above, and further in view of U.S. Patent 4,628,634 issued to Anderson.

(1) Review of the cited prior art. Anderson seeks to solve the problems associated with nursery stock containers that not only inconvenience the user but also fail to prevent damage to the root ball of the plant. (Anderson, col. 1, lines 57-60). Anderson discloses in FIG. 1 a container 10 for the soil and the roots of a plant 11 that form a root ball 12. (Anderson, col. 3, line 34-43). FIG. 2 shows these parts in exploded view, which includes the wall member 13 and the base 14, which together form a cylindrical enclosure for containing the soil and the roots of the plant. (Anderson, col. 3, lines 44-52). FIG. 4 shows an alternative base 14' that is conical in shape having an apex portion 15 that extends into the enclosure. *Id.* Anderson discloses that normally, it is desirable to provide drainage openings in either the wall member or base to remove excess water from the container. (Anderson, col. 8, lines 11-16).

(2) The cited prior art fails to teach or suggest each and every limitation of claims 8, 18 and 29. The Examiner has found that Single and Waterer lack a teaching or suggestion that the surface of the base is convex. (Final Office Action, p. 5, ¶ 1). Appellant asserts that the

Appeal Brief
Docket No.: WHIT/0019.A

Examiner has failed to present a *prima facie* case of obviousness because the prior art reference fail to teach or disclose each and every limitation of claims 8, 18 and 29. *In re Royka*, 490 F.2d at 985. Appellant claims that the base has a convex surface, wherein the convex surface has a shape comprising a central arch and a surrounding semihemispherical region (Claims 8 and 18) and alternatively, a central dome directing the roots outwardly. (Claim 29).

Anderson discloses a base that is either flat or conical with the conical base having an apex that extends into the plant container. The Examiner cites FIG. 4, Anderson for teaching the central arch 15, the semihemispherical region 16, 17 and the central dome 15. (Final Office Action, page 5, ¶ 4, page 6, ¶ 4 and page 7, ¶ 3, respectively). While the Examiner cites index 15 of FIG. 4 for both the central arch and the central dome, Anderson identifies index 15 as the apex of the conical shaped base. (Anderson, col. 3, lines 44-58) The Examiner further cites indices 16 and 17 as the semihemispherical region, but Anderson identifies index 16 as the periphery edge of the base 14 and the 17 as ears or tabs about the base. *Id.*

Since the cited prior art fails to teach or suggest each and every limitation claimed by Appellant in claims 8, 18 and 29, Appellant asserts that the Examiner has failed to provide a *prima facie* case of obviousness for claims 8, 18 and 29. Appellant therefore respectfully requests the Board to find that claims 8, 18 and 29 presented on appeal to be patentable.

(3) The cited prior art fails to teach or suggest each and every limitation of claims 21, 22 and 23. Appellant asserts that the Examiner has failed to present a *prima facie* case of obviousness because the prior art references fail to teach or disclose each and every limitation of claims 21, 22 and 23. *In re Royka*, 490 F.2d at 985. Appellant claims a sidewall having a plurality of protuberances and a base having a plurality of radially directed channels, wherein the channels are disposed to direct roots toward the plurality of protuberances, and wherein each

Appeal Brief
Docket No.: WHIT/0019.A

channel has a sidewall that directs roots toward an individual protuberance (Claim 21), wherein the channels extend into the proximal openings of the protuberances (Claim 22) and wherein the channels have a distal end with a deflecting curve (Claim 23).

The Examiner found that Single as modified by Waterer, FIG. 5, discloses channels having sidewalls that are disposed to direct roots towards the protuberances on the container. (Final Office Action, p. 6, ¶ 4). However, even if the cited prior art did teach or suggest such a structure, which Appellant asserts they do not, such is not what Appellant claims. Appellant claims that **each** channel has a sidewall that directs roots towards an **individual** protuberance. (Claim 21). The cited prior art is simply silent on such a structure because the cited prior art does not contemplate using channels to direct roots on the base of a container, either individually or combined.

The Examiner found that Single as modified by Waterer and Anderson lacks wherein the channels extend into the proximal openings of the protuberances (claim 22) or wherein each channel has a sidewall that directs roots towards an individual protuberance (claim 23). (Final Office Action, p. 6, ¶ 7 – p. 8, ¶ 2). Because the Examiner admits that the claimed limitations are not taught or suggested in the cited prior art, Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented for claims 21, 22 or 23. Therefore, Appellant respectfully requests the Board to find claims 21, 22 or 23 presented on appeal to be patentable.

(4) The rejection is based upon impermissible hindsight-based obviousness analysis by the Examiner. The Examiner has provided no evidence of the motivation to combine or modify the cited prior art references for claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41 and 61 and therefore has fallen into the hindsight trap, using information gleaned only from Appellant's

Appeal Brief
Docket No.: WHIT/0019.A

specification as the motivation to combine the cited prior art references. *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1138.

For example, regarding claim 5 wherein Appellant claims that the base has an upwardly facing surface that is convex, the Examiner states "It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ an upwardly facing surface as taught by Anderson on the base of Single as modified by Waterer in order to drain off excess water from the center and to guide the root growth in the proper direction."

First, the Examiner again mischaracterizes the teaching of Waterer and presents such mischaracterization as a motivation to combine the cited prior art references. Waterer does not teach or suggest "draining excess water from the center" as the Examiner claims but instead merely teaches draining water from the center hole of the flower pot. Furthermore, there is no suggestion or teaching from any of the references that the base has the purpose "to guide the root growth on the proper direction." This teaching is found **only in Appellant's specification**.

Regarding claim 20-24, the Examiner provides as the evidence of the motivation to combine the cited prior art references, that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the channels of Single as modified by Waterer and Anderson with deflecting curve and channels extending into the proximal openings, depending on how much root guidance is needed. (Final Office Action, p. 7, ¶ 1-2). All teachings regarding the guidance of roots by the base is **solely derived from Appellant's specification**.

Therefore, because the Examiner has provided no evidence of the motivation to combine the cited prior art references and because the Examiner has fallen into the hindsight trap by taking into account Appellant's teachings and knowledge concerning root guidance, gleaned only

Appeal Brief
Docket No.: WHIT/0019.A

from Appellant's specification, the Examiner has failed to provide a *prima facie* case of obviousness. Appellant respectfully requests the Board to find that claims 5-8, 12, 15-24, 29, 32-34, 36-38, 40, 41 and 61 presented on appeal are patentable.

(5) Summary. Therefore, Appellant respectfully asserts that the Examiner has failed to provide a *prima facie* case of obviousness for the reasons that follow.

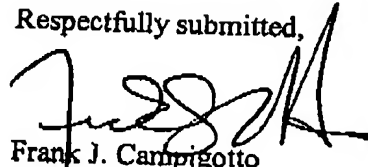
1. The cited prior art does not teach or suggest each and every limitation of claims 8, 18 and 29 namely, the cited prior art does not teach or suggest a base having a convex surface in the shape of a central arch and a surrounding semihemispherical region or a central dome.
2. The cited prior art fails to teach or suggest each and every limitation of claims 21, 22 and 23, namely, the cited prior art does not teach or suggest a sidewall having a plurality of protuberances and a base having a plurality of radially directed channels, wherein the channels are disposed to direct roots toward the plurality of protuberances, and wherein each channel has a sidewall that directs roots toward an individual protuberance (Claim 21), wherein the channels extend into the proximal openings of the protuberances (Claim 22) and wherein the channels have a distal end with a deflecting curve (Claim 23).
3. Since there is no evidence to support the combination of cited prior art references, it is only through the impermissible use of hindsight-based obviousness analysis and the use of knowledge gleaned only from Appellant's disclosure, that the Examiner has identified and combined the cited prior art references.
4. Appellant respectfully asserts that the Examiner has lost track of the "subject matter as a whole" and has impermissibly focused on the obviousness of substitutions and differences instead of focusing on the invention as a whole. Using impermissible hindsight-based obviousness analysis, the Examiner has sought to find in the cited references the limitations

Appeal Brief
Docket No.: WHIT/0019.A

claimed by Appellant without regard to either what the cited references teach or what Appellant's claimed invention is as a whole.

WHEREFORE, Appellant respectfully requests the Board find that all claims presented on appeal are patentable. The Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/WHIT/0019.A of the firm of the below-signed attorney in the amount of any necessary fees related to the filing of this document.

Respectfully submitted,



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Appeal Brief
Docket No.: WHIT/0019.A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE APPLICATION OF:	§	
Carl E. Whitcomb	§	
SERIAL NO: 10/823,379	§	EXAMINER: Nguyen, Son T.
CONFIRMATION NO.: 3362	§	
FILED: April 13, 2004	§	GROUP ART UNIT: 3643
FOR: Plant Container Base with Root-Directing Channels	§	Via Facsimile: 571-273-8300
	§	
	§	

APPENDICES IN SUPPORT OF APPELLANT'S APPEAL BRIEF

(8) CLAIMS APPENDIX	26
(9) EVIDENCE APPENDIX	33
(10) RELATED PROCEEDINGS APPENDIX	33

Appeal Brief
Docket No.: WHIT/0019.A

(8) CLAIMS APPENDIX

What is claimed is:

1. (original) A plant container, comprising:
 - a sidewall having a plurality of shoulders; and
 - a base supported on the shoulders, the base having an upwardly facing surface with a plurality of radially directed channels.
2. (original) The plant container of claim 1, wherein the sidewall and the base are separable.
3. (original) The plant container of claim 2, wherein the sidewall is a flexible panel that is bent and fastened in a closed curvilinear shape.
4. (original) The plant container of claim 3, wherein fastening the panel around the base constrains displacement of the base.
5. (original) The plant container of claim 1, wherein the upwardly facing surface is convex.
6. (original) The plant container of claim 5, wherein the convex surface has a shape selected from conical, semispherical, elliptical, and irregular.
7. (original) The plant container of claim 5, wherein the convex surface has a perimeter and a center that is between 1 and 2 inches higher than the perimeter.
8. (original) The plant container of claim 5, wherein the convex surface has a shape comprising a central arch and a surrounding semispherical region.
9. (original) The plant container of claim 1, wherein the upwardly facing surface has a center and a perimeter, and wherein the channels extend over more than half the distance between the center and the perimeter.

Appeal Brief
Docket No.: WHIT/0019.A

10. (original) The plant container of claim 1, wherein the plurality of shoulders are inwardly extending, outwardly extending, or combinations thereof.
11. (original) The plant container of claim 1, wherein the base has a generally circular perimeter.
12. (original) The plant container of claim 11, wherein the perimeter of the generally circular base has a plurality of projections.
13. (original) The plant container of claim 1, wherein the plurality of shoulders are provided by a plurality of protuberances.
14. (original) The plant container of claim 13, wherein the plurality of protuberances have a proximal opening in communication with a distal opening.
15. (original) The plant container of claim 14, wherein the base has a perimeter with a plurality of projections that extend into the plurality of protuberances through the proximal openings.
16. (original) The apparatus of claim 15, wherein the proximal openings are larger than the distal openings.
17. (original) The plant container of claim 16, wherein the convex face has a shape selected from conical, elliptical, semi-spherical, and irregular.
18. (original) The plant container of claim 16, wherein the convex face has an irregular shape comprising a central arch and a surrounding semi-spherical or frustoconical region.
19. (original) The plant container of claim 16, wherein the channels extend over more than half the distance from the center of the base to the perimeter of the base.

Appeal Brief
Docket No.: WHIT/0019.A

20. (original) The plant container of claim 19, wherein the channels are disposed to direct roots toward the plurality of protuberances.
21. (original) The plant container of claim 20, wherein each channel has a sidewall that directs roots toward an individual protuberance.
22. (original) The plant container of claim 20, wherein the channels extend into the proximal openings of the protuberances.
23. (original) The plant container of claim 21, wherein the channels have a distal end with a deflecting curve.
24. (original) The plant container of claim 21, wherein the individual protuberance is one of the plurality of protuberances that provide the plurality of shoulders.
25. (withdrawn) The plant container of claim 21, wherein the individual protuberance is not one of the plurality of protuberances that provide the plurality of shoulders.
26. (original) The plant container of claim 1, wherein the channels are between 0.1 and 1 inches tall.
27. (original) The plant container of claim 1, wherein the channels are between 0.15 and 0.75 inches tall.
28. (original) The plant container of claim 1, wherein the channels are between 0.25 and 0.5 inches tall.
29. (original) The plant container of claim 1, further comprising a central dome directing roots outwardly.

Appeal Brief
Docket No.: WHIT/0019.A

30. (withdrawn) The plant container of claim 1, wherein the channels are taller at a distal end than at a proximal end
31. (original) The plant container of claim 13, wherein the center of the proximal opening is positioned higher than the center of the distal opening when the panel is positioned upright.
32. (original) The plant container of claim 31, wherein the perimeter of the base has a plurality of projections that extend into the plurality of protuberances through the proximal opening.
33. (original) The plant container of claim 31, wherein the convex face has a shape selected from conical, elliptical, semi-spherical, irregular, and combinations thereof.
34. (original) The plant container of claim 31, wherein the convex face has an irregular shape comprising a central arch and a surrounding frustoconical or semi-spherical region.
35. (original) The plant container of claim 31, wherein the channels extend over more than half the distance from the center of the base to the perimeter of the base.
36. (original) The plant container of claim 29, wherein the channels are disposed to direct roots toward the plurality of protuberances.
37. (original) The plant container of claim 36, wherein each channel has a sidewall that directs roots toward an individual protuberance.
38. (original) The plant container of claim 37, wherein the individual protuberance is one of the plurality of protuberances that provide the plurality of shoulders.
39. (withdrawn) The plant container of claim 37, wherein the individual protuberance is not one of the plurality of protuberances that provide the plurality of shoulders.

Appeal Brief
Docket No.: WHIT/0019.A

40. (original) The plant container of claim 37, wherein the plurality of protuberances have a lower profile with a substantially horizontal region that receives the projections.
41. (original) The plant container of claim 40, wherein the proximal opening is larger than the distal opening.
42. (withdrawn) The plant container of claim 13, wherein the plurality of protuberances extend inward.
43. (withdrawn) The plant container of claim 42, wherein the sidewall further comprises a plurality of outwardly extending protuberances having a proximal opening in communication with a distal opening.
44. (withdrawn) The plant container of claim 43, wherein the perimeter of the base has a plurality of projections that extend into the plurality of outwardly extending protuberances through the proximal opening.
45. (withdrawn) The plant container of claim 44, wherein the channels are disposed to direct roots toward the plurality of protuberances.
46. (withdrawn) The plant container of claim 45, wherein each channel has a sidewall that directs roots toward an individual protuberance.
47. (withdrawn) The plant container of claim 46, wherein the individual protuberance is one of the plurality of protuberances that provide the plurality of shoulders.
48. (withdrawn) The plant container of claim 46, wherein the individual protuberance is not one of the plurality of protuberances that provide the plurality of shoulders.
49. (withdrawn) The plant container of claim 43, wherein the convex face has a shape selected from conical, elliptical, semi-spherical, irregular, and combinations thereof.

50. (withdrawn) The plant container of claim 43, wherein the convex face has an irregular shape comprising a central arch and a surrounding frustoconical region.
51. (withdrawn) The plant container of claim 43, wherein the channels extend over more than half the distance from the center of the base to the perimeter of the base.
52. (withdrawn) A plant container, comprising:
a base having an upwardly facing convex surface with a plurality of radially directed channels; and
a container sidewall extending upward around the perimeter of the base, wherein the sidewall includes a hole adjacent the plurality of radially-directed channels.
53. (withdrawn) The plant container of claim 52, wherein the convex surface comprises a central arch and a surrounding frustoconical or semi-spherical region.
54. (withdrawn) The plant container of claim 52, wherein the channels extend over more than half the distance from the center of the base to the perimeter of the base.
55. (withdrawn) The plant container of claim 52, wherein the channels have a distal end with a deflecting curve.
56. (withdrawn) The plant container of claim 52, wherein the channels extend above the surface by between 0.1 and 1 inches.
57. (withdrawn) A base for inserting in a plant container, comprising:
a base having an upwardly facing surface including a plurality of radially directed channels, a deflecting element near a distal end of each channel, and a root-tip-trapping element, wherein the deflecting element directs roots against a wall of the container at an angle that causes the root to deflect off the wall and into the root-tip-trapping element.

Appeal Brief
Docket No.: WHIT/0019.A

58. (withdrawn) The plant container of claim 57, wherein the upwardly facing surface is convex.
59. (withdrawn) The plant container of claim 58, wherein the convex surface has a shape selected from conical, semispherical, elliptical, and irregular.
60. (original) A plant container, comprising:
a container sidewall; and
a base secured to the container sidewall, the base having an upwardly facing surface with a plurality of radially directed channels.
61. (original) The plant container of claim 60, wherein the base has protrusions received within recesses in the container sidewall.
62. (original) The plant container of claim 60, wherein the channels are substantially free from obstructions to radial root growth.
63. (original) The plant container of claim 60, wherein the plurality of channels include at least eight channels.
64. (withdrawn) The plant container of claim 60, wherein the container sidewall comprises protuberances and the channels are directed toward the protuberances.

Appeal Brief
Docket No.: WHIT/0019.A

(9) EVIDENCE APPENDIX

NONE

(10) RELATED PROCEEDINGS APPENDIX

NONE